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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/226,107	01/07/1999	YASUNORI WATANABE	102491	1509
25944	7590	12/29/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER

2622

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/226,107

Applicant(s)

WATANABE ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-29 is/are allowed.
- 6) ☒ Claim(s) 1-11, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 12-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to the Request for Reconsideration*

1. Applicant's request for reconsideration was received on 6/1/04, and has been entered and made of record. Currently, **claims 1-29** are pending.

2. Applicant's arguments, see pages 1 and 2, filed 6/1/04, with respect to the rejection of independent **claims 1, 21, and 22**, cited under 35 U.S.C.102(e), as being anticipated by Takano *et al.* (U.S. Patent Number 6,078,765), have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly found reference of Takano (U.S. Patent Number 5,790,922).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-5, 7-11, 21, and 22** is rejected under 35 U.S.C. 102(e) as being anticipated by Takano (U.S. Patent Number 5,790,922).

Regarding **claim 1**, Takano discloses a multi-functional device (see Figs. 1-3) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig.

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2), a shaft supported on the outer casing (fulcrum A, column 5, line 65-column 6, line 9), a recording section that records images on a recording medium (fixing portion 11), and a reading section that reads images from a document (image reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (see Figs. 1-3), wherein when the reading section pivots away from the recording section such that the front edge moves forward and downward (see Fig. 3), a space is provided above the recording section (seen in Fig. 3), and the recording section is exposed outside through the space (seen in Fig. 3, column 5, line 65-column 6, line 9), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a rear end opposing the front end, and a lower surface (see Figs. 1 and 2), wherein the reading section is disposed on the lower surface of the control panel and pivotable together with the control panel (see Figs. 2 and 3), wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

Regarding **claim 2**, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is disposed closer to the front side of the outer casing than the recording section (see Figs. 1-3) and is pivotable toward the front side of the outer casing (see Figs. 1 and 3).

Regarding **claim 3**, Takano discloses the device discussed above in claim 1, and further teaches that the shaft (fulcrum A) is disposed adjacent to the recording section and disposed nearer the front side of the outer casing than the recording section (see Figs. 1 and 3).

Regarding **claim 4**, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is pivotable together with the control panel, such that the front end of the control panel moves downward (see Figs. 1-3).

Regarding **claim 5**, Takano discloses the device discussed above in claim 4, and further teaches of a document holding section that extends from the rear end of the control panel for supporting documents to be conveyed to the reading section (original tray 2b, column 3, lines 56-64), wherein the document holding section moves together with the reading section, and serves as a cover for covering the recording section when not moved open (see Figs. 1-3).

Regarding **claim 7**, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is disposed adjacent to the recording section and covers at least a portion of the recording section (see Figs. 1 and 3).

Regarding **claim 8**, Takano discloses the device discussed above in claim 4, and further teaches of a document discharge tray pivotally and detachably mounted near the front edge of the reading section for receiving documents discharged from the reading section (original ejection tray 8), wherein the document discharge tray is maintained at a predetermined angle with respect to a direction in which the documents are discharged when in use (see Figs. 1 and 2) and is pivotable in a direction opposite the pivoting direction of the reading section (whereby, as seen in Fig. 2, the tray 8 can inherently rotate in an upward direction, therein being opposite the pivoting direction of the reading section).

Regarding **claim 9**, Takano discloses the device discussed above in claim 8, and further teaches of a document discharge tray mounting portion on which the document discharge tray is mounted (see Figs. 1 and 2), wherein the document discharge tray is mounted on the document

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discharge tray mounting portion from upward (see Fig. 2, being inherent in the wire-shape tray 8).

Regarding *claim 10*, Takano discloses the device discussed above in claim 8, and further teaches of a recording paper discharge tray (original ejection tray 8) having an underside, right side and a left side, with the recording paper discharge tray being provided on the front end of the outer casing for receiving recording paper discharged from the recording section (see Figs. 1-3, and column 4, lines 58-67), the recording paper discharge tray normally slanting upward and being displaced downward due to contact from the reading section when the reading section pivots away from the recording section (see Figs. 1 and 3).

Regarding *claim 11*, Takano discloses the device discussed above in claim 10, and further teaches of an urging member (see Figs. 1 and 2), wherein the recording paper discharge tray is pivotally supported on the outer casing and is supported by the urging member to slant upward (see Figs. 1 and 3).

Regarding *claim 21*, Takano discloses a multi-functional device (see Figs. 1-3) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig. 2), a shaft supported on the outer casing (fulcrum A, column 5, line 65-column 6, line 9), a recording section that records images on a recording medium (fixing portion 11), a reading section that reads images from a document (image reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft in a manner that the front edge moves forward and downward so as to separate from the recording

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section (see Figs. 1-3), whereby a space is provided above the recording section (seen in Fig. 3), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a rear end opposing the front end, and a lower surface (see Figs. 1 and 2), wherein the reading section is disposed on the lower surface of the control panel and pivotable together with the control panel (see Figs. 2 and 3), wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

Regarding **claim 22**, Takano discloses a multi-functional device (see Figs. 1-3) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig. 2), a shaft supported on the outer casing (fulcrum A, column 5, line 65-column 6, line 9), a recording section that records images on a recording medium (fixing portion 11), a reading section that reads images from a document (image reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (see Figs. 1-3), wherein when the reading section pivots away from the recording section, a space is provided above the recording section (seen in Fig. 3), and the recording section is exposed outside through the space (seen in Fig. 3, column 5, line 65-column 6, line 9), wherein the shaft is located approximately halfway between the front edge and the back edge (see Fig. 3), and when the reading section pivots away from the recording section, the front edge moves below the shaft (see Fig. 3), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 1 and 2), a rear end opposing the front end, and a lower surface (see Figs. 1 and 2), wherein the reading section is disposed on the

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lower surface of the control panel and pivotable together with the control panel (see Figs. 2 and 3), wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Takano *et al.* (U.S. Patent Number 5,790,922) in view of Saito *et al.* (U.S. Patent Number 5,826,133, cited in the Office action dated 12/29/03).

Regarding **claim 6**, Takano discloses the device discussed above in claim 1, and further teaches that the recording section is provided with an ink cartridge that can be upwardly removed from the printer after pivoting the reading section away from the recording section (column 5, line 40-column 6, line 9). However, Takano fails to expressly disclose if the recording section comprises an ink-jet printer.

Saito discloses a device that comprises a reading section (304, column 9, lines 62 through 67) and a recording section (305, column 10, lines 1 through 7) whereby the recording section comprises an ink-jet printer (column 11, lines 45 through 57) provided with an ink cartridge that can be upwardly removed from the ink-jet printer after pivoting a section away from the recording section (column 5, lines 37 through 52).



Takano & Saito are combinable because they are from the same field of endeavor, being multi-functional devices having a reading section and a recording section.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have the recording section of Takano be the ink-jet printer of Saito.

The suggestion/motivation for doing so would have been that Takano's system would become usable to more customers, therein not being limited to just laser printing, but rather capable of utilizing any of the various well-known printing methods, as recognized by Saito in column 11, lines 45 through 57.

Therefore, it would have been obvious to combine the teachings of Saito with the system of Takano to obtain the invention as specified in claim 6.

*Allowable Subject Matter*

7. **Claims 12-20** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **Claims 23-29** are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 23**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the multi-functional device, as claimed, include the features of having the document discharge tray initially move integrally with the pivoting movement of the reading section, and after the document discharge tray has moved integrally with the pivoting movement of the reading section for a predetermined angle, the document discharge tray pivots in a direction opposite the pivoting direction of the reading section as the reading section pivots further. The closest prior art, Tanoue *et al.* (U.S. Patent Number 5,884,117), indicated in the Office action dated 5/5/03, teaches of the document discharge tray initially moving integrally with the pivoting movement of the reading section (seen as path D in Fig. 2), but fails to teach of the document discharge tray pivoting in a direction opposite the pivoting direction of the reading section as the reading section pivots further. Because of this feature, which was added in the amendment dated 10/22/03, the claim is rendered allowable.

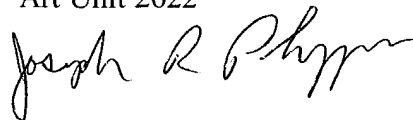
***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622



jrp